

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 provides for the use of the compounds of formula I and II for the preparation of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees et al (WO 98/46607, provided by Applicant).

Claims 1-9 are drawn to a composition comprising a compound of formula I and a compound of formula II, seed comprising said composition and a method of controlling fungi comprising treating the fungi with said composition.

Pees et al teaches synergistic compositions comprising the instantly claimed compound of formula I (claim 5, first compound), and other fungicidal compounds, including tebucanazole (compound of formula II), for use as an

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antifungal agent (p. 17, lines 19-22 and p. 18, line 15). Pees et al additionally teaches the composition further comprising a solid or liquid carrier for application (i.e. mixture applied simultaneously) to plants (at a dose of 0.1 to 10kg/ha), seed, soil or water to control harmful fungi, including *Phytophthora infestans*, which is of the class *Oomycetes* (p. 12, lines 6-21, p. 15, lines 10-12 and p. 23, lines 18 and 19). Pees et al does not teach the mixture comprising the compounds in a ration of 100:1 to 1:100, or applying the mixture to seed in an amount of 1 to 1000g/100kg of seed; However it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to optimize the ratio of the compounds and the amount applied to seed for maximum efficacy. This routine experimentation is common in the formulation art. Applicant is reminded of in re Aller, which affirmed that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Cotter et al (EP 0 998 790, provided by Applicant) teaches that 5-chloro-6-(2,4,6-trifluorophenyl)- [1,2,4]triazolo[1,5-a]pyrimidines (claims 1 and 4) are synergistically effective in controlling fungi when administered with tebuconazole (p. 2, figure I, p. 11, examples 2 and 3).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Stone whose telephone number is (571) 270-3494. The examiner can normally be reached on Monday-Thursday, 7:30am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614